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Expedited Procedure
Examining Group 1626

PATENT
3273-0121P

IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT: Yasutaka ISHII et al. CONF.: 5966
SERIAL NO: 09/622,001 GROUP: 1626
FILED: September 22, 2000 EXAMINER: Taofiq SOLOLA
FOR: PROCESS FOR PRODUCING ORGANIC COMPOUNDS USING
CATALYTIC IMIDE COMPOUNDS

#12
A. Harmon
11/29/02

RESPONSE TO PREMATURE FINAL REJECTION

BOX AF

November 19, 2002

Assistant Commissioner for Patent
Washington, D.C. 20231

Sir:

The Examiner is respectfully requested to ***withdraw the finality*** of the Office Action of August 22, 2002. MPEP 706.07(c) and 1002.02(c).

Claims 1-3 and 14-22 are pending in the application. As Applicants pointed out near the top of page 10 of the Amendment that was filed on August 7, 2002, claim 22 corresponds in scope to original claim 1. Original claim 1 was acknowledged by the Examiner to constitute a member of the elected invention group herein. Therefore there is no basis for withholding claim 22 from consideration on its merits. Also, the Office Action is not clear as to the status of claim 3. Accordingly, ***the Examiner is respectfully requested to issue an Office Action that treats claim 22 on its merits, and that clarifies the status of claim 3.***

Claims 1, 2, and 21 were rejected under the second paragraph of 35 USC 112 as failing to define the invention properly. This rejection is respectfully traversed, for the reasons set forth in the Amendment that was filed on August 7, 2002.

The Examiner argues that "oxygen-atom-containing compounds" is a description of a part of the compound and not the complete structure of the compound. This sort of claim has been recognized by the courts as capable of compliance with the statute. See e.g. *In re Barr et al.*, 170 USPQ 330.

The Examiner argues that imide is not a compound but a functional group on a compound. The present claims, however, provide a formula (1) which defines entire compounds.

The Examiner argues that a process is not classifiable without the structure of the product. This is irrelevant to the question of whether the present claims satisfy the requirements of the second paragraph of 35 USC 112.

The Examiner argues that a species is a specific compound, not a generic formula having variable substituents". *A species is a member of a genus*, and is not necessarily a specific compound. Alcohol (A11) in claim 3 is a species of compound capable of forming a stable radical (A) in claim 1, and α,β -unsaturated carboxylic acid (B12) in claim 3 is a species of radical scavenging compound (B) in claim 1.

The Examiner argues without providing convincing evidence thereof that "the invention is not 'clear and distinct' as required by 35 USC 112, second paragraph". This is the question under consideration rather than evidence relevant to answering the question. It is axiomatic that broad claims are not necessarily indefinite. See *In re Barr et al.*, cited above.

Claims 1-3 and 14-22 define generic and specific aspects of a single invention in the manner prescribed by the second paragraph of 35 USC 112.

Accordingly, withdrawal of the rejection of record and allowance of this application is respectfully solicited.

Each of claims 2, 3, and 14-20 herein depends from claim 1. Therefore there is no basis for withdrawing claims 3 and 14-20 from consideration on their merits. Also, claim 22 corresponds in scope to a claim acknowledged by the Examiner to be included within the elected invention group, so there is no basis for withdrawing claim 22 from consideration on its merits.

Conclusion

If the Examiner has any questions concerning this application, he is requested to contact Richard Gallagher, Reg. No. 28,781, at (703) 205-8000 in the Washington, D.C. area.

The Examiner is again respectfully requested to return to Applicants an initialed copy of the Form PTO-1449 that was filed concurrently with the present application papers on August 11, 2000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Richard Gallagher #28,781
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Appl. No.: 09/622,001 Group: 1626
Filed: September 22, 2000 Examiner: TAOFIQ SOLOLA
For: PROCESS FOR PRODUCING ORGANIC COMPOUNDS
USING CATALYTIC IMIDE COMPOUNDS

LARGE ENTITY TRANSMITTAL FORM

Assistant Commissioner for Patents
Washington, DC 20231

November 19, 2002

Sir:

Transmitted herewith is a Reply to Restriction/Election Requirement in the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ Petition for _____ (____) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- ☒ No fee is required.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

Appl. No. 09/622,001

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s)

(Rev. 09/19/02)